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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,863	08/27/2001	Michael Milbocker	Praxis-3	7242

7590 06/27/2005

PROMETHEAN SURGICAL DYNAMICS LLC  
3 GILL ST. #FIG  
WOBURN, MA 01801

EXAMINER
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PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/939,863	<b>Applicant(s)</b> MILBOCKER, MICHAEL	
	<b>Examiner</b> Paul B. Prebilic	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 4,6,7,11-13,17 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,11,13 and 30-37 is/are allowed.
- 6) ☒ Claim(s) 12 and 17 is/are rejected.
- 7) ☒ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/14/05</u> . | 6) <input type="checkbox"/> Other: _____  |

The indicated allowability of claim 17 has been withdrawn in view of newly found references. An Office action applying these references follows.

***Claim Objections***

Claims 4 and 6 are objected to because of the following informalities:

With regard to claims 4 and 6, the language "comprises one or more of . . . and . . . " is not proper for Markush language because it is not clearly closed to the elements of the listing; see MPEP 2173.05(h)(I) that is incorporated herein by reference. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Hammerslag (US 5,665,106). Hammerslag anticipates the claim language where the vascular patch is the prosthesis comprising a mesh that constitutes the absorbent pad as claimed; see column 2, lines 30-42 and column 9, lines 54-64.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usher (US 4,452,245) in view of Thierfelder et al (US 2002/0028980) or Amid (US 6,610,006). Usher discloses an inguinal hernia prosthetic fabric that constitutes a mesh of an absorbent pad, but fails to disclose the use of an adhesive coating thereof; see Figures 3 to 5 and column 6, line 35 to column 7, line 8. However, both Thierfelder (see paragraph [0128]) and Amid (see Figures 1 and 2 as well as column 3, line 35 to column 4, line 6) teach that it was known to use adhesive as a substitute or in addition to suturing as a means to attach the hernia patch to the body. Therefore, it is the Examiner's position that it would have been obvious to use adhesive in addition to the sutures of Usher as means to attach the prosthetic fabric so as to better secure the prosthetic material to the tissue.

Claims 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amid et al (US 6,610,006) alone. Amid discloses a prosthetic patch of mesh constituting an absorbent pad for the repair of inguinal hernias, but fails to disclose the step of coating the patch with adhesive; see supra. However, it is the Examiner's position that it would have been obvious to an ordinary artisan to coat the prosthetic patch of Amid with adhesive prior to attachment to tissue so that the prosthetic could be precoating well before surgery making the surgical procedure faster and more efficient.

***Allowable Subject Matter***

Claims 3, 7, 11, 13, and 30-37 are allowed over the prior art of record.

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### **Conclusion**

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
Art Unit 3738